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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,150	11/17/2003	Albert J. Kurpis	48900-22	5299
27799	7590	09/15/2004	EXAMINER	
COHEN, PONTANI, LIEBERMAN & PAVANE 551 FIFTH AVENUE SUITE 1210 NEW YORK, NY 10176			VANATTA, AMY B	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/716,150	Applicant(s) KURPIS, ALBERT J.	
	Examiner Amy B. Vanatta	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>111703</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species of the shield:

- I. Neck shield - Figs. 1-4
- II. Bib (i.e. combination neck shield and apron) - Figs. 5, 7B, 7C

Species of the means for forming the semi-tight seal:

- i. Affixing means - Figs. 2A-2B
- ii. Semi-resilient shape memory member inside of shield - Fig. 3
- iii. Elastic ring - Fig. 4

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Specifically, applicant must elect one of the species of the shield (I or II) and one of the species of the means for forming the semi-tight seal (i, ii, or iii). Currently, claims 1-3 and 13-14 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Teodor Holmberg on August 12, 2004 a provisional election was made with traverse to prosecute the invention of Species II (bib, Figs. 5, 7B, 7C) and Species "i" (affixing means of Figs. 2A-2B). Claims 1-7 and 13-20 are readable on the elected species. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

3. The use of the trademark "VELCRO" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 7 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 18 are rendered indefinite by the recitation of the trademark "Velcro" in the claims. A trademark is drawn to the source of a product and does not define any actual structure. The recitation of the trademark in the claims should be replaced with a recitation of the structure which is being claimed, such as "hook and loop fastener strips".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Flink (US 2,638,599).

Flink discloses an absorbent shield which wraps around the wrist and includes a means for forming a semi-tight seal with the flesh of the wearer, preventing the flow of fluid from a first part of the wearer's body (i.e. the hand) to a second part of the wearer's body (i.e. the arm); see col. 1, lines 5-11, 15-22, and 45-49; and col. 2, lines 19-22. The shield comprises an absorbent material forming at least a portion of the surface of the shield where the seal is formed with the flesh, this absorbent material being sponge (col. 1, line 41) as in claims 1 and 2. The combination of the semi-tight seal and the absorbent material forms a barrier which substantially prevents fluids from flowing onto the flesh at the second portion of the body, as in claim 1 (see col. 1, lines 5-11, 15-22, and 45-49; and col. 2, lines 19-22). The semi-tight seal is not so tight as to cause discomfort to the subject, as is clear from col. 1, lines 38-55, as in claim 1. It is noted, however, that this recitation as to the tightness of the seal is in part dependent upon the size of the wearer relative to the size of the shield, which does not further limit the actual structure of the shield itself, since the wearer's body part does not form a part of the claimed invention. Furthermore, the recitation with respect to the level of discomfort of the wearer does not further define the structure of the claimed device, since this is dependent upon the perceptions of the wearer.

With regard to claims 13 and 14, the shield of Flink is capable of being used in such manners and procedures. It is noted that these recitations in claims 13 and 14 are recitations of the intended use of the claimed device. It has been held that a recitation

with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

8. Claims 1, 3-6, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Daniel (US 3,798,674).

Daniel discloses an absorbent shield which wraps around the neck and drapes over the chest and shoulders of the wearer. The shield includes a means for forming a semi-tight seal with the flesh of the wearer (see collar 12) , preventing the flow of fluids, semi-fluids, or a combination thereof from a first part of the wearer's body (i.e. the portion of the neck above the collar) to a second part of the wearer's body (i.e. below the collar); see col. 2, lines 41-45. The shield comprises an absorbent material forming at least a portion of the surface of the shield where the seal is formed with the flesh (col. 1, lines 49-53; col. 2, lines 35-37; col. 3, lines 46-49). Daniel discloses that this absorbent material may comprise paper, as in claim 3 (see col. 3, line 48-49, disclosing that the drape is made of paper; it is noted that the "drape" referred to in col. 3, line 46 includes the bib and the collar portion, see col. 2, lines 4-6). The combination of the semi-tight seal and the absorbent material forms a barrier which substantially prevents fluids from flowing onto the flesh at the second portion of the body, as in claim 1. The semi-tight seal is not so tight as to cause discomfort to the subject, as is clear from the disclosure of col. 1, lines 36-53 and col. 3, lines 36-48, as in claim 1. It is noted, however, that this recitation as to the tightness of the seal is in part dependent upon the

size of the wearer relative to the size of the shield, which does not further limit the actual structure of the shield itself, since the wearer's body part does not form a part of the claimed invention. Furthermore, the recitation with respect to the level of discomfort of the wearer does not further define the structure of the claimed device, since this is dependent upon the perceptions of the wearer.

With regard to claims 4-7, the shield (12) of Daniel comprises a means for affixing (23) the wrap-around shield to the wearer, which forms the semi-tight seal (col. 3, lines 10-11). This means for affixing connects two end portions of the shield so as to encircle the wearer's neck, as in claim 6.

The shield of Daniel is disclosed as used in a hair care procedure, as in claim 13. With regard to claim 14, the shield of Daniel is capable of being used in such a manner. It is noted that the recitations in claim 14 are recitations of the intended use of the claimed device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

9. Claims 1, 4-7, 13-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Geniesse (US 5,572,740).

Geniesse discloses an absorbent shield which wraps around the neck and drapes over the chest and shoulders of the wearer. Regarding claim 1, the shield includes a means for forming a semi-tight seal with the flesh of the wearer (see collar

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13) , preventing the flow of fluids, semi-fluids, or a combination thereof from a first part of the wearer's body (i.e. the portion of the neck above the collar) to a second part of the wearer's body (i.e. below the collar); see col. 3, lines 10-14 and 34-38. The shield comprises an absorbent material forming at least a portion of the surface of the shield where the seal is formed with the flesh (col. 3, lines 34-38). The combination of the semi-tight seal and the absorbent material forms a barrier which substantially prevents fluids from flowing onto the flesh at the second portion of the body, as in claim 1. The semi-tight seal is not so tight as to cause discomfort to the subject, as is clear from the disclosure of col. 1, lines 10-14, as in claim 1.

With regard to claim 15, Geniesse discloses a bib as claimed, including a neck portion (13) forming a semi-tight seal with the flesh of the neck of the wearer and comprising an absorbent material (col. 3, lines 34-38 and col. 4, lines 61-62) forming at least a portion of the surface of the neck portion where the seal is formed. The combination of the semi-tight seal and absorbent material forms a barrier to fluids, semi-fluids, or a combination thereof as in claim 15. The bib includes an apron portion (11) connected to the neck portion (13) for covering at least a portion of the chest. The apron (11) includes an outer surface comprising an absorbent material (15); see Fig. 3 and col. 3, lines 47-49. The inner surface of the apron (11) comprises a liquid repellent material (16), as claimed (see Fig. 3 and col. 3, lines 50).

With regard to claims 4-7 and 17-18, the shield or neck portion (13) of Geniesse comprises a means for affixing the wrap-around shield to the wearer, which forms the semi-tight seal (col. 3, lines 3-14). This means for affixing (14) connects two end

portions of the shield so as to encircle the wearer's neck, as in claim 6. The fastener (4) forms a means for connecting as in claim 17. The fastener (14) is disclosed as being VELCRO-type hook and loop fastener strips, as in claims 7 and 18.

The shield of Geniesse is disclosed as used in a hair care procedure, as in claims 13 and 20. With regard to claim 14, the shield of Geniesse is capable of being used in such a manner. It is noted that the recitations in claim 14 are recitations of the intended use of the claimed device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 19, the apron portion (11) and the neck portion (13) of the bib of Geniesse are permanently connected by means of stitches (18).

10. Claims 1, 4-7, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Lock-Jones (US 5,230,100).

Lock-Jones discloses an absorbent shield which wraps around the neck and includes a means for forming a semi-tight seal with the flesh of the wearer (see 20 in Fig. 2), preventing the flow of fluids, semi-fluids, or a combination thereof from a first part of the wearer's body (i.e. the portion of the neck above the collar) to a second part of the wearer's body (i.e. below the collar); see col. 2, lines 35-39; and col. 4, lines 64-68. The shield comprises an absorbent material forming at least a portion of the surface of the shield where the seal is formed with the flesh (col. 2, lines 34-35 and col. 3, lines

57-59). The combination of the semi-tight seal and the absorbent material forms a barrier which substantially prevents fluids from flowing onto the flesh at the second portion of the body, as in claim 1. The semi-tight seal is not so tight as to cause discomfort to the subject, as is clear from the disclosure of col. 5, lines 31-34, as in claim 1.

With regard to claims 4-7, the shield (20) of Lock-Jones comprises a means for affixing the wrap-around shield to the wearer, which forms the semi-tight seal (col. 5, lines 27-34). This means for affixing (32) connects two end portions of the shield so as to encircle the wearer's neck, as in claim 6. The fastener (32) is disclosed as being VELCRO-type hook and loop fastener strips, as in claim 7 (col. 3, lines 3-5).

The shield of Lock-Jones is disclosed as used in a hair care procedure, as in claim 13. With regard to claim 14, the shield of Lock-Jones is capable of being used in such a manner. It is noted that the recitations in claim 14 are recitations of the intended use of the claimed device. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Geniesse (US 5,572,740) in view of Daniel (US 3,798,674).

Geniesse disclose a bib as claimed, including a neck portion (13) including an absorbent material (15) comprising at least a portion of the surface of the neck portion where the seal is formed with the flesh (col. 3, lines 34-38; Fig. 3). Geniesse teaches that this absorbent material is fabric, preferably terry cloth (col. 3, line 63- col. 4, line 2; col. 4, lines 61-64). Geniesse does not disclose the use of sponge, paper, or polymer for the absorbent material.

Daniel discloses a bib which has a seal formed by the neck portion (12), the neck portion comprising absorbent material which forms a surface of the neck portion where the seal is formed with the flesh (col. 1, lines 49-53; and col. 3, lines 46-49; it is noted that the "drape" referred to in col. 3, line 46 includes the bib and the collar portion, see col. 2, lines 4-6). Daniel discloses that this absorbent material may comprise terry cloth, or may comprise paper (see col. 3, lines 45-50). Daniel teaches that paper is "particularly suitable for use with men" ,and can be disposed of after each use if desired (col. 3, lines 48-50). Both Daniel and Geniesse disclose the use of their shield in a hair care procedure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the absorbent material of the neck portion (13) of the bib of Geniesse out of absorbent paper rather than out of fabric, in order to provide an inexpensive bib which is disposable after each use, as taught by Daniel.


Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy B. Vanatta whose telephone number is 703-308-2939. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Amy B. Vanatta
Primary Examiner
Art Unit 3765